

REMARKS

Claim Status

Claims 1-39 are pending in the application. This paper amends claims 1, 10, 11, 14, 20, 22, 24, 25, 31, 32, and 35. Claims 1, 10, 11, 21, and 31 are the independent claims of the application.

Interview Summary

A telephonic interview was conducted on or about March 21-22, 2007, between Examiner Raymond J. Bayerl of the U.S. Patent and Trademark Office and the undersigned attorney. Applicant and the undersigned attorney thank Examiner Bayerl for the courtesies extended during the interview.

Exhibits were not shown and demonstrations were not conducted during the interview. Claims 1 and 21 were discussed. The following reference was discussed: Berstis *et al.*, U.S. Patent Number 5,874,936. The undersigned attorney and the Examiner discussed applicability of this reference to the pending claims of the instant application, and whether additional limitations might, in Examiner's view, overcome the current claim rejections and put the claims in condition for allowance. Agreement was not reached.

Art Rejections

Summary of Rejections

All claims of the Application have been rejected as follows:

1. Claims 1-24, 27-34, and 36-39 stand rejected under 35 U.S.C. §102(b) as being anticipated by Berstis *et al.*, U.S. Patent Number 5,874,936 (“Berstis” hereinafter); and
2. Claims 25, 26, and 35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bertsis in view of Bates *et al.*, U.S. Patent Number 6,222,541 (“Bates” hereinafter).

Independent Claims 1, 10, 11, 21, and 31

Independent claim 1 had been previously amended to recite that the step of automatically scrolling is performed without user input. Independent claims 10, 11, 21, and 31 had been previously amended in an identical, similar, or analogous manner. Thus, each of these independent claims requires scrolling without user input. As we have argued, Berstis in contrast requires that a remote pointing device be operated by the user in order to scroll.

Referring to the decision on the previous appeal of this case, the Board of Appeal reasoned (pages 5-6) that according to Bertsis “once the cursor is placed on the floating border structure end, automatic scrolling occurs in direct response to the placement of the cursor as claimed.” The recitation of “without user input” in claim 1 and similar (or identical, or analogous) limitations in the other independent claims clearly require the automatic scrolling to be performed without user input, making the above reasoning used by the Board no longer applicable.

With regard to claims 21 and 31, the Board’s opinion (page 7) agreed with the Examiner’s argument that the formerly-recited clause of “even if the user does nothing” is not required to modify the language “automatically scrolling.” Instead, the Board reasoned that the clause in issue modifies its closest claim terminology. Applicant had previously amended claim 21 to recite

automatically scrolling the page while the user of the computer does nothing. Claim 31 had been amended in an identical, similar, or analogous manner. These amendments clearly require the step of automatically scrolling to take place without user action, and make the Board's reasoning no longer applicable. Again, Berstis's device requires continuing user action in order to scroll.

Furthermore, claim 1 has now been amended to clarify that *the step of automatically scrolling continues to be performed without user input.* Claims 10, 11, and 31 have been amended in an identical, similar, or analogous manner. Support for this limitation may be found in the specification, for example, on page 9, lines 4-18; and page 10, lines 10-13. Berstis does not disclose continuing or continuous scrolling without user input.

Applicant respectfully submits that Berstis fails to anticipate independent claims 1, 10, 11, 21, and 31 at least for the above reasons.

Claim 6

According to claim 6, automatic scrolling is resumed in response to clicking a left key of a mouse. In rejecting this claim, the Office Action asserted that "were a 'mouse' being used to control Berstis's cursor as an equivalent cursor-positioning means, this means waiting for the only affirmative continuance instruction available, 'clicking a left key'." Applicant respectfully submits that Berstis does not disclose resuming automatic scrolling, and more specifically does not disclose clicking a left key to resume scrolling. Moreover, clicking a left key need not be the only affirmative continuance instruction available.

As regards the equivalence argument, equivalence should not be considered in determining anticipation under section 102. To anticipate a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (*quoted with approval in* MPEP § 2131).

At least for these reasons, Applicant respectfully submits that dependent claim 6 is separately patentable over Berstis.

Claims 14, 25, and 35

Dependent claim 14 has been amended by adding the following limitation: *wherein the page comprises at least one link to additional linked information, and wherein the computer is further configured to automatically retrieve and display the additional linked information when the user does nothing*. Support for this limitation may be found in the specification, for example, on page 13, line 4, through page 14, line 2. Claims 25 and 35 have been amended in identical, similar, or analogous manner. Berstis does not disclose automatic link activation to retrieve and display the additional linked information when the user does nothing. Bates apparently also fails to disclose this limitation. See, for example, Bates, the Abstract: “. . . the user can select the link by simply pressing the right button of the mouse or using some other selection method.”

At least for these reasons, Applicant respectfully submits that dependent claim 14 is separately patentable over Berstis; and dependent claims 25 and 35 are separately patentable over Berstis and Bates.

Claim 20

Dependent claim 20 has now been amended to recite that the plurality of autoscrolling controls includes all five controls. Berstis does not disclose this limitation.

At least for this reason, Applicant respectfully submits that dependent claim 20 is separately patentable over Berstis.

Other Dependent Claims

Dependent claims not specifically discussed should be patentable together with their respective base claims and intervening claims, if any.

CONCLUSION

For the foregoing reasons, Applicant respectfully submits that all pending claims are patentable. To discuss any matter pertaining to the present application, the Examiner is invited to call the undersigned attorney at (858) 720-9431.

Having made an effort to bring the application in condition for allowance, a timely notice to this effect is earnestly solicited.

Respectfully submitted,

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